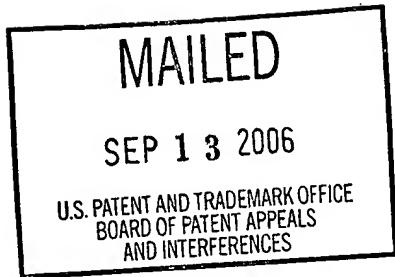


The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ERNEST W. MOODY



Appeal No. 2006-1909
Application No. 10/621,768
Technology Center 3700

ON BRIEF

Before BAHR, NAPPI and HORNER, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the examiner's final rejection of claims 1-4, all of the claims pending in the application.

We reverse.

BACKGROUND

The appellant's invention relates to a method of playing a card game in which the player is awarded a predetermined amount after a first round of play based on the player's final poker hand ranking, the amount of the player's wager, and a first pay table. The player may either collect the award or parlay at least a portion of the award into a second round of play in which a second pay table is used. Claim 1 is representative of the subject matter on appeal, and a copy of this claim can be found in the appendix to the appellant's brief.

The examiner relies upon the following as evidence of unpatentability:

Moody <i>et al.</i> (Moody)	6,419,578	Jul. 16, 2002
Gajor	6,443,456	Sep. 03, 2002

The appellant seeks our review of the examiner's rejection of claims 1-4 under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of Moody in view of Gajor.

Rather than reiterate in detail the conflicting viewpoints advanced by the examiner and the appellant regarding this appeal, we make reference to the examiner's answer (mailed April 25, 2005) for the examiner's complete reasoning in support of the rejection and to the appellant's brief (filed January 12, 2005) for the appellant's arguments.

OPINION

In reaching our decision in this appeal, we have carefully considered the appellant's specification and claims, the applied prior art, and the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations that follow. It is our view that, after consideration of the record before us, the examiner has failed to make a *prima facie* showing of obviousness-type double patenting of the claimed invention in view of claims 1-24 of Moody in view of Gajor.

In the rejection of independent claim 1, the examiner has determined that the patented claims 1-24 of Moody "set forth the same invention of substantially the same scope as pending claim 1 except that the invention of patented claims 1-24 lack the parlay feature." The examiner relies on Gajor for support that "it is well known in the art to use a parlay feature in game play to provide players with additional wagering options." (Examiner's Answer, p. 4). The examiner concludes, "[I]t would have been obvious to one of ordinary skill in the art to modify the patented method of play of claims 1-24 by including a parlay feature for game play in order to increase the potential payout. (Examiner's Answer, p. 5).

The appellant provides two arguments to rebut the obviousness-type double patenting rejection. First, the appellant contends the invention of claims 1-24 of Moody does not make any bonus event determinations based on the final five card hand of the player. Rather, the bonus determination of the Moody claims is based on the initial five cards in the player's hand. (Appellant's Brief, p. 5). The appellant thus concludes that the examiner has

failed to make a *prima facie* case that it would have been obvious to modify any of the methods of play of claims 1-24 of Moody to use the player's final five card hand to determine bonus events. (Appellant's Brief, p. 8).

Second, the appellant argues that neither the Moody claims nor Gajor teach or suggest a game in which the bonus event is a second round play using a pay table with a different overall game return than the pay table used in the first round of play. (Appellant's Brief, p. 6). The appellant thus argues that even if the teachings of Gajor were combined with claims 1-24 of Moody, this combination does not meet the limitation of claims 1-4. Moody does not include a parlay feature at all, as admitted by the examiner, and Gajor's parlay wager is an additional wager on a separate outcome that may occur in the first round. (Appellant's Brief, pp. 6-7). Gajor's method does not use the player's winnings from the first round of play toward a second round of play that uses a pay table that has a different overall game return than the first pay table from the first round of play. (Appellant's Brief, pp. 7-8). The appellant thus argues that the examiner has failed to make a *prima facie* case that it would have been obvious to modify any of the methods of play of claims 1-24 of Moody to: (1) use at least a portion of the player's winnings from the first round of play in a second round of play, and (2) use a second pay table in the second round of play that has a different overall game return than the pay table used in the first round of play. (Appellant's Brief, pp. 8-9).

We reverse the examiner's rejection.

The issue to consider when determining whether a nonstatutory basis exists for a double patenting rejection is whether any claim in the application defines an invention that is merely an obvious variation of an invention claimed in another patent.¹ The analysis employed in an obviousness-type double patenting determination parallels the guidelines for an obviousness determination under 35 U.S.C. § 103(a). *In re Braat*, 937 F.2d 589, 593-94, 19 USPQ2d 1289, 1292-93 (Fed. Cir. 1991); see also *In re Longi*, 759 F.2d 887, 892 n. 4, 225 USPQ 645, 648 n.4 (Fed. Cir. 1985). As such, to determine obviousness we consider the factors set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966), *viz.*, (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art.² In this case, the “prior art” being considered is claims 1-24 of Moody in view of Gajor.

Claims 1-24 of Moody recite displaying an initial first hand of five cards to a player. If the player’s initial five card hand contains a certain pre-selected arrangement of cards, the player is given a bonus event, i.e., the option of using a second pay table in place of the first pay table during the first round of play (claim 1), awarding the player a second hand of five cards (claim 16), or awarding the player bonus rounds of play (claim 22). Moody’s

¹ In this case, since the application at issue was filed later than the Moody patent, only a one-way determination of obviousness is needed in resolving the issue of double patenting, i.e., whether the invention defined in a claim in the application would have been an obvious variation of the invention defined in a claim in the patent. M.P.E.P. § 804 (August 2001).

² Although *Graham* also suggests analysis of secondary considerations such as commercial success, long felt but unsolved needs, failure of others, etc., the appellant presented no such evidence of secondary considerations for the Board’s consideration.

claims do not recite allowing the player the option to use a second pay table during a second round of play.

Gajor discloses providing a player in a video poker game with a parlay option when a player is playing multiple hands of the game simultaneously. The parlay option allows the player to obtain a larger payoff by combining multiple winning hands. If a player draws winning hands on more than one hand, he wins more than a player who selects to receive a straight payoff option that pays a normal payoff for each winning hand. This parlay option offers the player a second, higher pay table for multiple winning hands during the first round of play. Gajor fails to teach or suggest paying out the winnings on a first round of play using a first pay table and then allowing the user to play another round using a second pay table.

As such, we find that neither the Moody claims nor Gajor teach or suggest allowing a player with a winning hand in a first round of play to parlay a portion of the award to use in a second round of play using a second pay table that is different than the first pay table used in the first round of play. The examiner has failed to provide a clear articulation of why one of ordinary skill in the art at the time of the invention, with the knowledge of the teachings of the Moody claims and Gajor, would have been led to the invention recited in the pending claims. The only reasoning provided by the examiner was that one would be motivated to include a parlay feature to increase the potential payout. We note, however, that there are many ways to include a parlay feature that differ from the parlay method claimed, as demonstrated in Gajor. As such, we do not see, absent hindsight

reconstruction, how the Moody claims in view of the teachings of Gajor would have led one of ordinary skill in the art to the invention as recited in claims 1-4. Accordingly, we reverse the examiner's rejection of claims 1-4.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-4 is reversed.

REVERSED



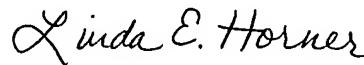
JENNIFER D. BAHR
Administrative Patent Judge

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ROBERT E. NAPPI
Administrative Patent Judge

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LINDA E. HORNER
Administrative Patent Judge

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JOHN EDWARD ROETHEL
2290 S. JONES BLVD. #100
LAS VEGAS, NV 89146